




Australian Government

IP Australia

# Regulation Changes Proposed To Implement Trans-Tasman Initiatives: Consultation Paper

December 2014

A blurred photograph of a modern building interior with a glass facade and a curved staircase. People are walking through the space. The image is overlaid with a purple tint.

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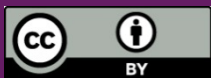
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# Introduction

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This paper discusses regulation changes proposed to implement the trans-Tasman initiatives in the Intellectual Property Laws Amendment Bill 2014.

IP Australia invites interested parties to make written submissions on the proposals by **15 February 2015**.

**Written submissions should be sent to [consultation@ipaaustralia.gov.au](mailto:consultation@ipaaustralia.gov.au).**

For accessibility reasons, please submit responses by email in Word, RTF or PDF format.

The contact officer is Lisa Bailey, who may be contacted on (02) 6283 7961.

Please note that, unless requested otherwise, written comments submitted to IP Australia may be made publicly available on our website and may be disclosed to other Commonwealth agencies, including, but not limited to, the Department of Industry.

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- how you may seek access to and correction of the personal information we hold;
- how you may make a complaint about a breach of the Privacy Act and how we will deal with your complaint; and
- IP Australia's Privacy Contact Officer details.

A request made under the *Freedom of Information Act 1982* for access to a submission marked confidential will be determined in accordance with that Act.

**Submissions should be received no later than 15 February 2015.**

# Overview

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In August 2009, the then Prime Ministers of Australia and New Zealand agreed on a trans-Tasman Outcomes Framework to support the Single Economic Market (SEM) agenda. The outcomes included a trans-Tasman regulatory framework for patent attorneys in both jurisdictions ('trans-Tasman patent attorney regime'), and a single application process for patents in both jurisdictions. In February 2011, the Prime Ministers of Australia and of New Zealand also announced their agreement to work towards establishing a joint patent examination system.

Legislative changes are required in both countries to give effect to the trans-Tasman patent attorney regime, and the single application and examination processes ('the SEM initiatives').

The Australian Government introduced the [Intellectual Property Laws Amendment Bill 2014](#) ('the Bill') into the Australian Parliament in March 2014. Schedule 4 to the Bill contains amendments to the *Patents Act 1990*, *Trade Marks Act 1995*, *Plant Breeder's Rights Act 1994* ('PBR Act') and the *Designs Act 2003* to allow the implementing of the SEM initiatives in Australia. The Bill was passed in the House of Representatives in November 2014, and is currently awaiting debate in the Senate.

In addition to the Australian Bill, the New Zealand Patents Act 2013 would require amendment to allow for implementation of the SEM initiatives in New Zealand. A Bill is expected to be introduced into New Zealand Parliament in 2015.

Following passage of the Australian and New Zealand Bills, amendments will also be required to the Australian patent regulations and to the New Zealand patent regulations to implement the SEM initiatives.

Part A of this paper sets out proposals for amendment of the Australian regulations to implement the trans-Tasman patent attorney regime in Australia.

Part B of this paper gives a preliminary overview of what changes may be required to the *Patents Regulations 1991* to implement the proposed single patent application process ('SAP') and the proposed single patent examination process ('SEP') for Australia and New Zealand. A separate consultation process outlining the operational details of SAP and SEP is planned to occur following the completion of further work by Australia and New Zealand.

**IP Australia is seeking comment on whether there would be any issues associated with the regulatory proposals outlined in this paper, and if so, how these issues might be addressed.**

**IP Australia invites interested parties to provide written submissions on the proposals, by 15 February 2015.**

# A—Trans-Tasman Patent Attorney Regime

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## 1. Introduction

Patent attorneys constitute a specialised profession who assist businesses by drafting applications for the grant of patents and prosecuting those applications before patent offices. Currently, Australia and New Zealand each have their own longstanding systems for registration and regulation of patent attorneys.

In addition, the Trans-Tasman Mutual Recognition Arrangement ('TTMRA'), signed in 1996, allows for the reciprocal registration of members of certain occupations, including patent attorneys. The majority of Australian and New Zealand patent attorneys are currently registered in both countries under the TTMRA, and pay fees in both countries. Registration under the TTMRA does not require that Australian or New Zealand patent attorneys demonstrate their competence in the law and practice of the other country to be registered there.

The trans-Tasman patent attorney regime is primarily designed to increase business confidence in the quality and standard of service provided by patent attorneys, to streamline processes, to minimise the cost of regulation of patent attorneys in both Australia and New Zealand, and to facilitate competition in the market for patent attorney services.

A bilateral arrangement to support the trans-Tasman patent attorney regime was signed in March 2013 by the relevant Australian and New Zealand Ministers, and is publicly available on the IP Australia website.<sup>1</sup> The bilateral arrangement sets out how the proposed framework for the joint attorney regime would be implemented.

IP Australia is now considering the necessary changes to the Australian regulations to implement the trans-Tasman patent attorney regime. These regulations would be the *Patents Regulations 1991*, the *Trans-Tasman Proceedings Regulation 2012*, the *Trade Marks Regulations 1995*, the *Designs Regulations 2003* and the *Plant Breeder's Rights Regulations 1994* ('PBR Regulations').

## 2. Proposals for amendments to the Australian regulations

### 2.1 General operation of patent attorney regulations in Australia and New Zealand

It is proposed that new general provisions would be inserted into Chapters 20, 20A and 22 of the Patents Regulations to ensure that:

- functions or powers under Chapters 20 or 20A may be performed or exercised in Australia or New Zealand; and
- it is immaterial whether an act, omission or other matter mentioned in Chapters 20 or 20A takes place in Australia or New Zealand; and
- for decisions that are subject to Administrative Appeals Tribunal (AAT) review—it is immaterial whether a decision is made in Australia or New Zealand.

This proposed approach is designed to avoid having to set out specific statements in each regulation that confers a function or power, or mentions an act, omission, reviewable decision or other matter.

The exception to this approach is that the Australian *criminal* offence provisions<sup>2</sup>, which relate to persons failing to comply with procedural directions during disciplinary proceedings, are not proposed to apply in New Zealand. Instead, it is proposed that a person in New Zealand who fails to comply with these directions would be dealt with under New Zealand criminal offence provisions. See also section 2.6.6 below.

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<sup>1</sup> [http://www.ipaustralia.gov.au/pdfs/13-04-02\\_Bilateral\\_Arrangement\\_Final\\_Version.pdf](http://www.ipaustralia.gov.au/pdfs/13-04-02_Bilateral_Arrangement_Final_Version.pdf).

<sup>2</sup> Regulation 20.38(3), 20.41, 20A.13(3) and 20A.16.

## **2.2 Registration requirements for patent attorneys**

Currently an individual seeking registration as an Australian patent attorney must satisfy several requirements detailed in the Patents Act and Patents Regulations. These requirements include educational, employment and residency obligations. Outlined below are proposals for changes to the regulations governing registration of patent attorneys under the trans-Tasman patent attorney regime.

### **2.2.1 Recognising the New Zealand Qualification Framework**

Currently, an individual seeking registration as a patent attorney must have, or be entitled to, an Australian Qualifications Framework ('AQF') qualification from the higher education sector, or an equivalent qualification awarded by an overseas institution.

New Zealand has its own qualifications framework: the New Zealand Qualifications Framework ('NZQF').<sup>3</sup> It is proposed that the Patents Regulations would be amended so that an NZQF qualification is treated in the same manner as an AQF qualification, rather than as an overseas qualification.

### **2.2.2 Knowledge requirements for registration**

Currently, the Professional Standards Board for Patent and Trade Marks Attorneys assesses whether or not an individual has sufficient knowledge of intellectual property law and practice in order to practise as a patent attorney. To do this, the Professional Standards Board takes into account whether the applicant meets the minimum knowledge requirements set out in the Patents Regulations.

In line with Article 4.8 of the bilateral arrangement, it is proposed that Parts 2 and 5 of Schedule 5 to the Patents Regulations would be amended so that courses of study meeting the minimum knowledge requirements must provide for students to have:

- an appropriate level of understanding of the Australian and the New Zealand legal systems and how intellectual property rights may be protected
- an appropriate level of understanding of the systems of protecting and exploiting trade marks, patents and designs, in Australia, in New Zealand and in other countries.

The proposed amendments would apply after commencement to assessing whether individuals meet the knowledge requirements. It is proposed that the new Board (see section 2.5) would reasonably apply the new knowledge requirements, so that they would not disadvantage any individual who had relied on a course being accredited before commencement. These individuals would include those who:

- pass an accredited course of study before commencement; or
- start an accredited course of study before commencement, but pass that course after commencement.

### **2.2.3 Residency requirement for registration**

The Bill proposes the repeal of the requirement for individuals to be ordinarily resident in Australia to be registered as patent attorneys.<sup>4</sup> Consequently, it is proposed to remove from the Patent Regulations the requirement for an individual's application for registration as a patent attorney to be accompanied by evidence of ordinary residence in Australia.

### **2.2.4 Employment experience for registration**

Currently, an individual seeking registration as a patent attorney must have been employed in preparing, filing and prosecuting patent applications for at least two years in the last five years. The

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<sup>3</sup> Information on the Framework can be found at <http://www.nzqa.govt.nz/studying-in-new-zealand/nzqf/>.

<sup>4</sup> Item 18 in Part 1 of Schedule 4 to the Bill would repeal paragraph 198(4)(a) of the Patents Act.

employment must not only have provided experience with Australian applications, but also experience with applications in other countries, particularly Australia's major trading partners.

Article 4.5(b) of the bilateral arrangement sets out that the Designated Manager would only register persons as patent attorneys who have completed two years' work experience to the satisfaction of the Designated Manager.

### ***Place of employment***

It is proposed that the Patents Regulations would be amended so that the required employment must be in Australia, in New Zealand or in both countries.

### ***Experience in employment***

Under the trans-Tasman patent attorney regime, individuals registered as patent attorneys will be free to practise in Australia and in New Zealand. For the continuing high reputation of the patent attorney profession, it will be important for new entrants to the profession to demonstrate that they are competent to practise before both countries' patent offices.

It is therefore proposed that the regulations be amended to require experience in preparing, filing and prosecuting patent applications before the Australian and New Zealand patent offices, and before the offices of countries that are regarded as major trading partners with Australia and New Zealand.

### ***Flexible application of new requirement***

It is proposed that the Designated Manager, who assesses whether applicants for registration meet the employment requirement, would flexibly apply the new requirements to applicants who had started their period of required employment before commencement. For example, if the majority of work experience was undertaken prior to commencement, the Designated Manager would be able to treat that period of employment as complying with the new requirements, so as to ensure that an applicant is not disadvantaged by commencement of the new regime.

## **2.2.5 Convictions and sentences for offences that disqualify individuals from registration**

Currently, an individual cannot be registered as an Australian patent attorney if convicted of an offence under Australia's patents, trade marks or designs legislation in the previous five years, or if the individual is currently under sentence of imprisonment for an offence of dishonesty with a maximum penalty of 2 years imprisonment.

Amendments to the Patent Regulations are proposed to also prescribe being convicted of offences against:

- the *Patents Act 1953* (NZ);
- the *Patents Act 2013* (NZ);
- the *Trade Marks Act 2002* (NZ);
- the *Designs Act 1953* (NZ);
- the *Plant Variety Rights Act 1986* (NZ); or
- the *Plant Breeder's Rights Act 1994* (Cth).<sup>5</sup>

Amendments to the Patents Regulations are also proposed so that an individual under sentence of imprisonment in New Zealand for an offence of dishonesty would be disqualified from being registered as a patent attorney, in just the same way as someone under sentence of imprisonment in Australia.

It is proposed that these amendments would apply to convictions occurring before or after commencement. This ensures that the newly prescribed offences would disqualify a person from registration, in just the same way as the currently prescribed offences do.

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<sup>5</sup> Inclusion of offences against the New Zealand and the Australian plant varieties legislation is proposed because the process for obtaining rights under that legislation is analogous to the process in each country for obtaining patents.



## **2.2.6 Incorporated patent attorneys—company registration in Australia or New Zealand**

The Bill would amend the Patents Act to permit companies registered under the New Zealand Companies Act 1993 to become incorporated patent attorneys in Australia. Consequential amendments are proposed to the Patents Regulations so that a New Zealand company must prove that it is registered under the New Zealand Companies Act in the same circumstances that an Australian company must prove that it is registered under the *Corporations Act 2001*.<sup>6</sup>

## **2.3 Transitional arrangements**

### **2.3.1 Transitional qualification of New Zealand candidates for registration**

To be registered as a patent attorney, an individual must hold qualifications meeting the academic and knowledge requirements. As a transitional measure, and as set out in Part IX of the bilateral arrangement, the Bill would permit the Patents Regulations to provide an alternative qualification for those individuals who have commenced the current process in New Zealand for qualifying as patent attorneys.<sup>7</sup>

Accordingly, new regulations are proposed in the Patents Regulations so that doing all of the following is a qualification for registration as a patent attorney ('transitional qualification'):

- passing one or more of the subjects of examination conducted in New Zealand under Part 30 of the Patents Regulations 1954 (NZ) ('qualifying examinations') before commencement
- passing the remaining qualifying examinations before the end of the four year period beginning at commencement; and
- applying for registration as a patent attorney in Australia within six months of receiving written notification from the New Zealand Commissioner of Patents that the last qualifying examination(s) has been passed.

As a result, an individual who obtains this transitional qualification would not be required to meet the academic and knowledge requirements that apply to other applicants for registration. However, it is proposed that the individual would still be required to comply with the employment, good character and non-criminality requirements for registration.

In line with the proposals in section 2.2.4, it is proposed that the Designated Manager would flexibly apply the Australian employment requirements to transitional candidates who had started their period of required employment before commencement.

### **2.3.2 Transitional registration of New Zealand patent attorneys as Australian trade marks attorneys**

New Zealand does not currently have a trade mark attorney profession, but a number of patent attorneys practise as trade mark specialists. As set out in Part VIII of the bilateral arrangement, the Bill would provide for a New Zealand-registered patent attorney to be transitionally registered in the Australian Register of Trade Marks Attorneys, provided that certain criteria are met.<sup>8</sup> As a result, an individual can be transitionally registered without meeting the academic and knowledge requirements applying to other applicants for registration.

Accordingly, new regulations in the Trade Marks Regulations are proposed to prescribe:

- how the application for transitional registration is to be made, including that it must:
  - be in writing, in a form approved by the Designated Manager; and
  - be accompanied by the applicant's statement of experience in the form of a declaration (see point 2 below); and

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<sup>6</sup> See paragraph 198(9)(c) of the Patents Act; regulations 20A.3 and 20A.22 of the Patents Regulations.

<sup>7</sup> Item 82 in Part 2 of Schedule 4 of the Bill.

<sup>8</sup> See Item 84 in Part 2 of Schedule 4 to the Bill.

- be accompanied by a declaration that the applicant has not been convicted of a prescribed offence in the previous five years, or is not under sentence of imprisonment for a prescribed offence (see point 4 below); and
- be accompanied by the fee applying to ordinary applications for registration as a trade marks attorney;<sup>9</sup>
- that the statement of experience should detail the extent of the applicant's experience in:
  - searching trade marks records; and
  - preparing, filing and prosecuting trade marks applications in New Zealand, in Australia and in other countries and organisations regarded as those countries' major trading partners; and
  - advising on the validity and infringement of registered trade marks;
- that only experience gained within the last five years before making the application is to be taken into account; and
- the offences for which conviction in the previous five years, or being under sentence of imprisonment, will disqualify the individual from transitional registration as a trade marks attorney. These are to be the same as those disqualifying individuals from registration as patent attorneys.<sup>10</sup>

## 2.4 Address for Service

The Bill would amend existing provisions for service of documents in the Designs Act, Patents Act, PBR Act and Trade Marks Act to permit documents to be served on, or given or sent to, an address for service in Australia or New Zealand by prescribed means.<sup>11</sup> The means proposed to be prescribed in the Designs, the Patents, the PBR and the Trade Marks Regulations will be those currently available—by leaving the document at the address or by sending it there by post.

Amendments to the Designs, the Patents, the PBR and the Trade Marks Regulations are also proposed to permit any of the following addresses to be provided as an address for service, on or after commencement:

- an address in Australia or New Zealand at which a document may be given to someone personally or to the person's representative; or
- an address in Australia to which it is practicable and reasonable for Australia Post, or a person acting on behalf of Australia Post, to deliver mail (e.g. a post office box); or
- an address in New Zealand to which it is practicable and reasonable for a person providing mail-delivering services to deliver mail.<sup>12</sup>

The PBR Act and Regulations do not currently require a person completing an approved form with an address for service field to state such an address in every case. For consistency with the other legislation, it is proposed that new provisions be inserted into the PBR Regulations that require an address for service be provided.

## 2.5 Trans-Tasman IP Attorneys Board

The Bill would amend the Patents Act to continue the role and functions of the existing Professional Standards Board for Patent and Trade Marks Attorneys as the new Trans-Tasman IP Attorneys

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<sup>9</sup> See item 28 in Schedule 9 to the Trade Marks Regulations.

<sup>10</sup> See subregulation 20.12 of the Patents Regulations as proposed to be amended by section 2.2.5.

<sup>11</sup> See items 1 to 4 (amending the Designs Act); items 28 to 31 (amending the Patents Act); items 59 to 67 (amending the PBR Act) and items 72 to 77 (amending the Trade Marks Act) in Part 1, Schedule 4 to the Bill.

<sup>12</sup> New Zealand has a number of independent postal service providers that can deliver mail in New Zealand rather than a single provider of postal services. It is intended that the Regulations be sufficiently broad to cover all potential service providers.

Board ('the Board').<sup>13</sup> The Bill would also insert provisions into the Patents Act to provide for the membership of the Board, including the Board's composition, Ministerial appointment of members and their periods of appointment.<sup>14</sup>

### **2.5.1 Quorum of the Board**

The Patents Regulations currently provide that a quorum at a meeting of the Board is formed by the majority of the members of the Board.

Article 5.5 of the bilateral arrangement states that a quorum for any of the meeting of the Board will consist of a majority of the Board members being present at the meeting, including at least one member from New Zealand. It is proposed that the Patents Regulations be amended in line with that article, but that they should also require that a quorum comprise at least one member who resides in Australia.

## **2.6 Trans-Tasman IP Attorneys Disciplinary Tribunal**

Currently the Patents Regulations establishes the single-member Patent and Trade Marks Attorneys Disciplinary Tribunal ('Disciplinary Tribunal') and provides for appointment to, and removal from that office. The person who is the Disciplinary Tribunal must be currently enrolled as a legal practitioner in Australia, and have been enrolled for at least seven years.

Under Part VI of the bilateral arrangement, the Disciplinary Tribunal is to be known as the Trans-Tasman IP Attorneys Disciplinary Tribunal and is to be comprised of one experienced legal practitioner and two experienced registered or formerly registered patent attorneys appointed by the Australian Minister. The Trans-Tasman IP Attorneys Disciplinary Tribunal would include at least one person from New Zealand when it is determining a complaint in relation to a registered patent attorney from New Zealand.

### **2.6.1 Continuing Disciplinary Tribunal—effect and reconstitution**

Amendments are proposed to the Patents Regulations to:

- rename the Disciplinary Tribunal as the Trans-Tasman IP Attorneys Disciplinary Tribunal to reflect its expanded role; and
- provide a new multi-member constitution for the Trans-Tasman IP Attorneys Disciplinary Tribunal.

It is proposed that the Trans-Tasman IP Attorneys Disciplinary Tribunal would consist of:

- a President—who must have the same qualification for appointment as the current single-member Disciplinary Tribunal (see above); and
- at least two patent attorney members—who could be currently registered or have retired from practice.<sup>15</sup>

It is proposed that the Australian Minister would appoint a pool of members to the Trans-Tasman IP Attorneys Disciplinary Tribunal. Every disciplinary proceeding would be heard by a three-person hearing panel consisting of the President and two other members selected by the President from the pool for that proceeding.

If the disciplinary proceedings are against an individual registered attorney who resides in Australia or in New Zealand, it is proposed the regulations be amended to require that a member of the hearing panel must reside in the same country as the patent attorney being heard. This member could be the President or one of the other members. It is proposed that the pool will contain trade marks attorneys, for the purposes of disciplinary matters concerning trade marks attorneys.

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<sup>13</sup> See item 40 in Part 1 of Schedule 4 to the Bill.

<sup>14</sup> See item 42 of Part 1 of Schedule 4 to the Bill.

<sup>15</sup> The existing provisions of subregulations 20.62(2) to (6) of the Patents Regulations are proposed to apply to all substantive members.

It is proposed that the Patents Regulations also be amended to permit the Australian Minister to appoint a person to act temporarily as the President, in the absence of the substantive President.

Consistent with the current regulations<sup>16</sup>, it is proposed that the President and the other members selected for a hearing panel should be obliged to:

- disclose conflicts of duty and/or interest to the parties (the Board and the attorney who is the subject of the disciplinary proceedings); and
- not perform his or her functions on the hearing panel without the consent of the parties.

It is proposed that if a member of a hearing panel or the President fails to disclose a conflict (without reasonable excuse), this would be one of the grounds for terminating that person's appointment to the Trans-Tasman IP Attorneys Disciplinary Tribunal.

If such a conflict is discovered during hearings, or a member becomes otherwise unavailable (e.g. due to illness), the President would be able to reconstitute the hearing panel:

- if the President discovers a conflict or is otherwise unavailable, an acting President should be appointed for those proceedings, just as a person may be appointed under current Patents Regulation 20.63; and
- if another member discovers a conflict or becomes otherwise unavailable, the President might:
  - select another member from the pool, particularly if there has not yet been a hearing; or
  - continue the proceedings with only one other member on the hearing panel. This would be appropriate if there have already been hearings, and the panel continues to meet all other requirements for constitution of the Trans-Tasman IP Attorneys Disciplinary Tribunal.

The President would preside at any hearing. Decisions of the hearing panel would be by majority, with all votes having equal weight. If the hearing panel is reconstituted with the President and only one other member, then any decision would be required to be unanimous.

It is proposed that the person constituting the single-member Disciplinary Tribunal immediately before commencement would become the President of the Trans-Tasman IP Attorneys Disciplinary Tribunal on commencement. That person's transitional appointment to the office of President would continue for what is left of their period of appointment to the current single-member Disciplinary Tribunal at commencement.<sup>17</sup>

For any disciplinary proceedings before the single-member Disciplinary Tribunal at commencement, it is proposed that these should continue before the President alone, under the relevant provisions of the Patents Regulations or of the Trade Marks Regulations as they are immediately before commencement.

It is proposed that the existing protections under Australian law for the person constituting the Disciplinary Tribunal would be extended to all members of a panel hearing disciplinary proceedings, including when the Trans-Tasman IP Attorneys Disciplinary Tribunal sits in New Zealand (see 2.6.2 below).<sup>18</sup> As set out in Article 6.7 of the bilateral arrangement, it is proposed that New Zealand law would give similar protection to members of the Trans-Tasman IP Attorneys Disciplinary Tribunal, when sitting in New Zealand.

### ***2.6.2 Provisions to permit remote appearances from New Zealand and to permit the Disciplinary Tribunal to sit in New Zealand***

It is proposed that the Australian and New Zealand trans-Tasman proceedings legislation would allow persons in New Zealand to take part remotely (e.g. by video-conference) in:

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<sup>16</sup> See regulation 20.64 of the Patents Regulations.

<sup>17</sup> A person is appointed as the Disciplinary Tribunal for a period specified in the instrument of appointment, see subregulation 20.62(3) of the Patents Regulations.

<sup>18</sup> For existing protections, see regulation 20.42 of the Patents Regulations.

- disciplinary proceedings before the Trans-Tasman IP Attorneys Disciplinary Tribunal sitting in Australia; or
- review proceedings under the Australian patents legislation before the AAT.

To that end, it is proposed that the Australian Trans-Tasman Proceedings Regulations would be amended to prescribe the Trans-Tasman IP Attorneys Disciplinary Tribunal and the AAT for remote appearances from New Zealand.<sup>19</sup>

It is also proposed that provisions be inserted into the Patents Regulations to allow the Trans-Tasman IP Attorneys Disciplinary Tribunal to sit in New Zealand to hear disciplinary proceedings against a registered attorney who resides there—if the Trans-Tasman IP Attorneys Disciplinary Tribunal considers it appropriate in the circumstances of the case.

### **2.6.3 Permitting remote appearances from Australia to New Zealand, within New Zealand or within Australia**

The Australian and New Zealand trans-Tasman proceedings legislation does not provide for remote appearance from Australia to the Trans-Tasman IP Attorneys Disciplinary Tribunal sitting in New Zealand. This is because it is an Australian, not a New Zealand tribunal. Nor does the trans-Tasman proceedings legislation provide for remote appearances within New Zealand or within Australia.

It is therefore proposed that new provisions, directly modelled on those in Part 6 of the Australian Trans-Tasman Proceedings Act, be inserted into the Patents Regulations to permit remote appearances:

- from Australia to the Trans-Tasman IP Attorneys Disciplinary Tribunal sitting in New Zealand
- within New Zealand, if the Trans-Tasman IP Attorneys Disciplinary Tribunal chooses to sit in New Zealand; or
- within Australia, if the Trans-Tasman IP Attorneys Disciplinary Tribunal is sitting in Australia.

It is also proposed that the Trade Marks Regulations would be amended to allow registered trade marks attorneys in Australia to appear remotely before the Trans-Tasman IP Attorneys Disciplinary Tribunal.

### **2.6.4 Taking into account previous findings in disciplinary proceedings**

It is proposed that, as is currently the case, the Trans-Tasman IP Attorneys Disciplinary Tribunal could take into account findings in proceedings before the existing Disciplinary Tribunal and the former Patent Attorneys Disciplinary Tribunal. It is also proposed that the Board could refer to decisions of the existing Disciplinary Tribunal when applying to the Trans-Tasman IP Attorneys Disciplinary Tribunal to cancel or suspend an incorporated attorney's registration.

### **2.6.5 Commencement of disciplinary proceedings**

Currently the Board must commence disciplinary proceedings by way of written notice given to the Disciplinary Tribunal. The Board is then to give a copy of this notice to the registered patent attorney who is the subject of the notice.<sup>20</sup> To strengthen this process under the trans-Tasman regime, amendments are proposed to require that the Trans-Tasman IP Attorneys Board must provide written notice by post to the patent attorney in question, when giving the notice to the Trans-Tasman IP Attorneys Disciplinary Tribunal. This would apply whether the patent attorney resides in Australia or in New Zealand.

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<sup>19</sup> Part 6 of the [Trans-Tasman Proceedings Regulation 2012 \(Cth\)](#); see also paragraphs [47\(1\)\(b\)](#) and [49\(1\)\(c\)](#) of the [Trans-Tasman Proceedings Act 2010 \(Cth\)](#).

<sup>20</sup> See regulation 20.35 of the Patents Regulations.

### **2.6.6 Providing information to New Zealand's law enforcement authorities**

As discussed in section 2.1, the criminal offences in the Patents Regulations will not extend to conduct in New Zealand. These are proposed to be dealt with under equivalent criminal offence provisions included in the New Zealand implementing legislation.

These criminal offences relate to conduct during the substantive disciplinary proceedings before the Trans-Tasman IP Attorneys Disciplinary Tribunal. They include failing to comply with the Trans-Tasman IP Attorneys Disciplinary Tribunal's directions or summons. So that the New Zealand law enforcement authorities are aware of such any such conduct, IP Australia proposes that the Patents Regulations should permit the President of the Trans-Tasman IP Attorneys Disciplinary Tribunal to provide personal information to New Zealand's law enforcement authorities where appropriate.

### **2.7 Transitional arrangement for discipline for pre-commencement conduct in New Zealand**

Currently, under section 102 of the Patents Act 1953 (NZ), continued in effect by paragraph 248(e) of the Patents Act 2013 (NZ), the New Zealand High Court can order the removal of the name of a patent attorney from the New Zealand register of patent attorneys or the suspension from practice before the New Zealand Patent Office. Under subsection 102(3) of that Act, a name removed from the New Zealand register of patent attorneys cannot be re-entered in the register, except at the court's direction.

As set out in Part IX of the bilateral arrangement, the Bill would require, as soon as practicable after commencement, the Designated Manager to enter the names of all patent attorneys registered in New Zealand in the Australian register, which will then be the Trans-Tasman Register of Patent Attorneys.

As set out in Article 9.12 of the bilateral arrangement, the existing New Zealand disciplinary regime under section 102 of the Patents Act 1953 (NZ) would continue to apply after the implementation of trans-Tasman registration regime for actions and behaviours of patent attorneys in New Zealand before implementation. Accordingly, amendments are proposed to the Patents Regulations to ensure that:

- the existing New Zealand disciplinary regime would continue to apply to an individual patent attorney's misconduct in New Zealand before commencement of the new trans-Tasman regime ; and
- effect can be given in Australia to decisions made in New Zealand after commencement under that disciplinary regime.

It is proposed that the Designated Manager must remove an individual attorney's name from the Trans-Tasman Register of Patent Attorneys, if the New Zealand Commissioner of Patents advises the Designated Manager in writing that all of the following apply:

- the individual was registered as a patent attorney in New Zealand at commencement
- the New Zealand High Court has determined that the individual should not practise as a patent attorney in New Zealand; and
- the New Zealand High Court's determination relates solely to conduct occurring in New Zealand before commencement; and
- all rights of appeal in New Zealand have been exhausted and the decision still stands.

It is proposed that a name removed from the Trans-Tasman Register of Patent Attorneys under this provision could only be re-entered if the New Zealand Commissioner of Patents advises the Designated Manager in writing that the New Zealand High Court has directed that the individual's name may be entered on the register again.

## B—Single patent application and examination

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### 3. Introduction

As part of the SEM initiatives, Schedule 4 to the Bill also proposes amendments to the *Patents Act 1990* to allow the proposed Single Application Process ('SAP') and the proposed Single Examination Process ('SEP'). These aim to streamline the process for applying for patents in Australia and New Zealand, and for the examination of common applications:

- SAP is proposed to allow each country's IP Office to accept the filing of standard patent applications, correspondence and other documents and accept the payment of fees, with the result that the documents are taken to be filed and the fees paid under the other country's law; and
- SEP is proposed to allow an examiner in either country to simultaneously examine corresponding applications for grant of patents under both countries' laws, as a delegate of each country's Commissioner of Patents.

In addition to the proposed amendments in the Bill to implement SAP and SEP, changes to the *Patent Regulations 1991* are required. The proposed regulation changes are broadly outlined below.

Amendments to the New Zealand Patents Act 2013 are also required to enable SAP and SEP to be implemented. A bilateral arrangement between the Australian and New Zealand governments is being developed to support the implementation of SAP and SEP.

### 4. Filing Australian patents documents in New Zealand

The Bill proposes amendments to section 214 of the Patents Act to permit prescribed documents filed in a prescribed manner with New Zealand patents officials to be taken to be filed at the Australian Patent Office.<sup>21</sup> This would save applicants having to file documents in both Australia and New Zealand for corresponding applications for grant of a patent for the same invention in each country.

New provisions would be required in both the Australia and the New Zealand patents regulations to prescribe the Australian patents documents that could be filed in New Zealand. The patents documents relevant for SAP and SEP would be all those necessary for the filing and examination of an application for a standard patent.

The Australian Patent Regulations would also need to reflect that the New Zealand patents regulations usually require all patents documents to be filed electronically by means of the online case management system currently operated by the Intellectual Property Office of New Zealand ('IPONZ').

As permitted under proposed new subsection 214(3) of the Patents Act, the Australian patents regulations would also need to provide for when a prescribed Australian patent document filed in IPONZ's online case management system is taken to be filed at the Australian Patent Office for the purposes of the Australian patents legislation.

Based on section 14A of the *Electronic Transactions Act 1999* (Cth), it is proposed that the Australian regulations would deem the date and time of filing of an Australian patent document in IPONZ's online case management system to be the time in Canberra, Australia when the electronic communication of the information in the document reaches IPONZ's online case management system.

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<sup>21</sup> See item 27 in Part 1 of Schedule 4 to the Bill.

## 5. Filing of New Zealand patents documents in Australia

IP Australia proposes that no change would be needed to the Australian Patent Regulations to permit Australian patents officials to receive New Zealand patents documents on behalf of New Zealand. New Zealand implementing legislation will provide for New Zealand documents to be filed with IP Australia.

## 6. Paying Australian patents fees in New Zealand

The Bill is proposed to amend section 227 of the Patents Act to permit fees prescribed in the Australian legislation to be paid in New Zealand currency to New Zealand patents officials.<sup>22</sup> This would allow someone filing an Australian patent document with a New Zealand patents official to pay any fee due at filing, without having to make a separate payment in Australia.

It is proposed that new regulations would:

- (i) declare the Australian patents fees that can be paid in New Zealand;
- (ii) empower the Australian and New Zealand Commissioners of Patents to jointly determine the amount of the declared fees in New Zealand dollars, which would allow them to vary the New Zealand dollar amounts of those fees when there is a significant change in the A\$/NZ\$ exchange rate; and
- (iii) require the fee determinations to be published online to take effect.

IP Australia and the New Zealand Ministry of Business, Innovation & Employment ('MBIE') are working to develop a framework for varying the New Zealand dollar amounts of the Australian fees. It would guide the Australian and New Zealand Commissioners of Patents in deciding when to vary the New Zealand dollar amounts, and by how much. It is also to require that the money received by the New Zealand patents official on behalf of the Australian government be held in trust and be reconciled periodically.

## 7. Paying New Zealand patents fees in Australia

The Bill is proposed to insert new section 227AA into the Patents Act to permit officials and employees in IP Australia to receive specified New Zealand patents fees in Australian dollars.<sup>23</sup> This will allow someone filing a New Zealand patent document with IP Australia to pay any fee due at filing, without having to make a separate payment in New Zealand.

It is proposed that new regulations would:

- (i) authorise the Commissioner, a Deputy Commissioner or an employee in the Patent Office to receive the specified fees on behalf of New Zealand;
- (ii) specify the New Zealand patents fees that can be paid in Australia, including identifying the relevant New Zealand law under which they are payable;
- (iii) require the fees to be paid in Australian dollars;
- (iv) empower the Australian and New Zealand Commissioners of Patents to jointly determine the amount of the specified fees in Australian dollars. This would allow them to vary the Australian dollar amounts of those fees when there is a significant change in the A\$/NZ\$ exchange rate; and
- (v) require the fee determinations to be published online to take effect.

The framework to be established between IP Australia and MBIE (discussed in section 6 above) would guide the Australian and New Zealand Commissioners of Patents in deciding to vary the Australian dollar amounts of the New Zealand fees. It would also require that the money received by IP Australia on behalf of the New Zealand government be held in trust and be reconciled periodically.

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<sup>22</sup> See item 36 in Part 1 of Schedule 4 to the Bill.

<sup>23</sup> See item 37 in Part 1 of Schedule 4 to the Bill.



